APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,405	03/29/2005	Christian Scheering	2003P00251WOUS	1353

7590   05/16/2007

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EXAMINER
PARK, JEONG S

ART UNIT	PAPER NUMBER
2109	

MAIL DATE	DELIVERY MODE
05/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/529,405	SCHEERING, CHRISTIAN
	Examiner	Art Unit	
	Jeong S. Park	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication,.even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _29 March 2005_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _17-36_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _17-36_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _29 March 2005_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _3/29/2005_.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claims 18-20, 23, 27, 29, 31, 32 and 34-36 are objected to because of the following informalities:

In claim 18, line 2, the phrase "the Internet protocol" should be corrected as – Internet protocol-- for clear understanding of the claim;

In claim 19, line 2, the word "it" should be corrected as –the domain name-- for clear understanding of the claim;

In claim 20, line 2, the phrase "the associated servers" should be corrected as – associated parameter servers-- for clear understanding of the claim;

In claim 20, line 6, the phrase "the content of the text field" should be corrected as –a content of the text field-- for clear understanding of the claim;

In claim 20, line 6, the word "the response" should be corrected as –a response-- for clear understanding of the claim;

In claim 23, line 2, the word "the DHCP" should be corrected as –DHCP-- for clear understanding of the claim;

In claim 27, line 2, the phrase "the associated servers" should be corrected as -- associated parameter servers-- for clear understanding of the claim;

In claim 27, line 4, the phrase "the data record" should be corrected as –a data record-- for clear understanding of the claim;

In claim 27, line 5, the phrase "the content of this text field" should be corrected as –a content of this text field-- for clear understanding of the claim;

In claim 29, line 1, the phrase "the DHCP method" should be corrected as –a

DHCP method-- for clear understanding of the claim;

In claim 31, line 2, the phrase "the basis of the Internet protocol" should be

corrected as –a basis of Internet protocol-- for clear understanding of the claim;

In claim 32, line 2, the phrase "the associated servers" should be corrected as –

associated parameter servers-- for clear understanding of the claim;

In claim 32, line 2, the phrase "the respective names of domains" should be

corrected as –respective names of domains-- for clear understanding of the claim;

In claim 32, line 4, the phrase "the data record" should be corrected as –a data

record-- for clear understanding of the claim;

In claim 32, line 5, the word "the response" should be corrected as –a response--

for clear understanding of the claim;

In claim 32, line 5, the phrase "the content of this text field" should be corrected

as –a content of this text field-- for clear understanding of the claim;

In claim 34, line 3, the phrase "a domain name" should be corrected as –the

domain name-- for clear understanding of the claim;

In claim 34, line 3, the phrase "the DHCP method" should be corrected as –a

DHCP method-- for clear understanding of the claim;

In claim 35, line 2, the phrase "the name of this domain" should be corrected as –

a name of this domain-- for clear understanding of the claim;

In claim 36, line 2, the phrase "a data record" should be corrected as –the data

record-- for clear understanding of the claim; and

In claim 36, line 4, the phrase "a real domain" should be corrected as –the real

domain-- for clear understanding of the claim.

Appropriate correction is required.

Double Patenting

2.   A rejection based on double patenting of the "same invention" type finds its
support in the language of 35 U.S.C. 101 which states that "whoever invents or
discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis
added). Thus, the term "same invention," in this context, means an invention drawn to
identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re
Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164
USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by
canceling or amending the conflicting claims so they are no longer coextensive in
scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection
based upon 35 U.S.C. 101.

3.   Claims 17, 26 and 30 are provisionally rejected under 35 U.S.C. 101 as claiming

the same invention as that of claims 23 and 27 of copending Application No.

10/884,485.

Because the copending application teaches all the limitations of the applicant's

claims as listed above.

This is a <u>provisional</u> double patenting rejection since the conflicting claims have

not in fact been patented.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Where applicant acts as his or her own lexicographer to specifically define a term

of a claim contrary to its ordinary meaning, the written description must clearly redefine

the claim term and set forth the uncommon definition so as to put one reasonably skilled

in the art on notice that the applicant intended to so redefine that claim term. *Process*

Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed.

Cir. 1999).

5.   The term "Internet addresses" in claims 17, 26 and 30 is used by the claim to

mean "addresses converted from domain names by the addressing server, which

defined with domain name server in the following claim", while the accepted terminology

in the art is "Internet protocol addresses." The term is indefinite because the

specification does not clearly redefine the term. Examiner recommends replacing

"Internet addresses" in the indicated claims with –Internet protocol addresses--.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 17, 19-30 and 32-36 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Reichmeyer et al. (hereinafter Reichmeyer)(U.S. Patent No.

6,286,038 B1) in view of Choudhry (U.S. Patent No. 6,442,602 B1).

Regarding claims 17, 19, 21, 26 and 33, Reichmeyer teaches as follows:

A method for configuring a device in a data network, comprising the following

steps (a method of remotely configuring a network device, see, e.g., abstract);

Storing a domain name in the device (DHCP client, 10 in figure 1 or Network

device, 61 in figure 8)(Dynamic Host Configuration Protocol (DHCP) assigns dynamic

Internet Protocol address to devices on a network, see, e.g., col. 3, lines 62-65);

Transmitting a request message (DHCP request, 18 in figure 1) comprising the

domain name (server identification or network IP address) to an addressing server

(DHCP server, 14 in figure 1) by the device (DHCP client, 10 in figure 1)(DHCP client

broadcast DHCP request message to the DHCP server selected, each request

message including a server identification, see, e.g., col. 4, lines 14-17);

Transmitting address information (IP address) of a parameter server (central

configuration server, 26 in figure 3 and 8) associated with the device (network device,

61 in figure 8) to the device by the addressing server (DHCP server, 52 in figure 3 and

8), in response to the request message (the network device obtains an IP address for

the central configuration server from the DHCP server, see, e.g., col. 7, lines 59-65 and

figure 8, steps 18 and 20);

Setting up a connection to the parameter server (central configuration server) by

the device, the device using the address information (obtained IP address for the central

configuration server) setting up the connection (network device sends a request

message, 110 in figure 8, to the central configuration server, see, e.g., col. 7, line 65 to

col. 8, line 5); and

Transmitting parameters (configuration information) to the device by the

parameter server (central configuration server), wherein the parameters are used to

configure the device (the central configuration server sends a response message, 116

in figure 8, to the network device including configuration information, see, e.g., col. 8,

lines 10-14).

Reichmeyer does not teach that the addressing server is used to convert between domain names and Internet addresses. Because the network device automatically get the network IP address (domain name) associated with the network device so the DHCP server does not need to convert between the domain name and IP addresses.

Choudhry teaches as follows:

Domain name server (DNS) provides the translation between domain names and IP addresses (DNS functions same as the addressing server, see, e.g., col. 2, lines 52-56).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Reichmeyer to include DNS server to translate between domain names and IP addresses as taught by Choudhry in order to provide names and addresses to network devices automatically without human intervention.

Regarding claims 20, 27 and 32, Reichmeyer teaches as follows:

The Internet protocol addresses of the associated servers (IP address for the central configuration server) and the respective names of domains (IP address for the network device) are stored in the addressing server (DHCP server)(see, e.g., col. 7, lines 59-65);

The address information of the parameter server (IP address for the central configuration server) associated with the device is stored in a text field of a data record belonging to the domain name associated with this device (any protocols used in the

network communication have certain form of data unit including text fields to store

information); and

The content of the text field is sent to the device as the response (DHCP sever

responds with a DHCP offer message, 16 in figure 1 and 8, see, e.g., col. 4, lines 4-10).

Regarding claims 22 and 28, Reichmeyer teaches all the limitations of claims 17

and 26 except for the manual input of the domain name, because the network device

automatically learns the domain name by the DHCP mechanism.

It would have been obvious for one of ordinary skill in the art at the time of the

invention to modify Reichmeyer to include manual input of the domain name in the

network device in order not to take advantage of using DHCP automatic discovery of

the domain name.

Regarding claims 23, 29 and 34, Reichmeyer teaches as follows:

After the device (DHCP device) has been started up, the DHCP method is used

to send the domain name for storing to the device and/or the DHCP method is used to

assign a valid Internet address (IP address of the DHCP client) to the device (when a

DHCP client boots, it transmits a DHCP discover message and the DHCP server

responds with available IP address, see, e.g., col. 4, lines 4-10 and figure 8).

Regarding claims 24, 25 and 36, Reichmeyer teaches all the limitations of claims

17 and 30 except for using a fictitious domain name and a real domain is stored in the

device as the domain name.

Choudhry teaches as follows:

Fictitious domain (virtual subdomain name, 53 in figure 5) name does not belong

to a real domain (URL is not recognized by the standard DNS is called as the virtual subdomain name, 51 in figure 5, see, e.g., col. 6, lines 36-40 and fig 4);

Both the fictitious domain name (virtual subdomain name, 53 in figure 5) and a real domain name (known domain name, 50 in figure 5) are used (see, e.g., col. 6, lines 53-62 and figure 5);

A first attempt is used to transmit the request message (41 in figure4) with the real domain name (known domain name, 50 in figure 5) to the addressing server (DNS), if no address information can be ascertained in the addressing server using the domain name transmitted in the first attempt then the addressing server sends a negative acknowledgement message (error 404, 42 in figure 4) to the device as address information (web browser requests URL. If the URL is not recognized by the DNS, the server will return a "error 404:file not found" page to the web browser, see, e.g., col. 6, lines 36-40 and fig 4); and

A terminal using a second attempt send a further request message with the fictitious domain name (virtual subdomain name, 53 in figure 5) to the addressing server (see, e.g., col. 6, lines 58-62 and 53 in figure 5).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Reichmeyer to include using a fictitious domain name and a real domain as domain name in the process of getting IP addresses from domain names by DNS as taught by Choudhry in order to provide more reliable domain naming service for directing multiple possible domain names to the correct IP address.

Regarding claim 30, Reichmeyer teaches as follows:

An arrangement for configuring a device in a data network (a method of remotely configuring a network device, see, e.g., abstract), the device having a memory for storing a domain name, the arrangement comprising;

A parameter server (central configuration server, 26 in figure 3 and 8) for storing parameters (configuration information), which can be used to configure the device for operation in the data network (the central configuration server sends a response message, 116 in figure 8, to the network device including configuration information, see, e.g., col. 8, lines 10-14);

The device (workstation or network device or DHCP client connected to SDR, 64 in figure 3), the addressing server (DHCP server, 52 in figure 3), and the parameter server (central configuration server, 26 in figure 3) are connected via the data network (see, e.g., col. 5, lines 60-64 and figure 3);

The device is designed to transmit a request message (DHCP request, 18 in figure 1) to the addressing server (DHCP server, 14 in figure 1)(DHCP client broadcast DHCP request message to the DHCP server selected, see, e.g., col. 4, lines 14-17);

Request message comprising the domain name stored in the device (network device obtained own IP address from the step 12 in fig 8 and use the IP address to communicate with the DHCP server, see, e.g., col. 7, lines 59-65);

The addressing server (DHCP server) comprises a mechanism for transmitting an address information of the parameter server (central configuration server) assigned to the device to the device by using the domain name transmitted by the device, in response to the request message (the network device obtains an IP address for the

central configuration server from the DHCP server, see, e.g., col. 7, lines 59-65 and figure 8, steps 18 and 20); and

The parameter server is adapted to send parameters to the device (the central configuration server sends a response message, 116 in figure 8, to the network device including configuration information, see, e.g., col. 8, lines 10-14).

Reichmeyer does not teach that the addressing server is used to allocate domain names to Internet protocol addresses. Because the network device automatically get the network IP address (domain name) associated with the network device so the DHCP server does not need to allocate domain names to IP addresses.

Choudhry teaches as follows:

Domain name server (DNS) provides the translation between domain names and IP addresses (DNS functions same as the addressing server, see, e.g., col. 2, lines 52-56).

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Reichmeyer to include DNS server to translate between domain names and IP addresses as taught by Choudhry in order to provide names and addresses to network devices automatically without human intervention.

Regarding claim 35, Reichmeyer teaches as follows:

The device (DHCP client, 10 in figure 1) is assigned to a domain in the data network, and the domain name sent in the request message (DHCP request, 18 in figure 1) is the name of this domain (DHCP client broadcast DHCP request message to the DHCP server selected, each request message including a server identification

which as the same as a network IP address, see, e.g., col. 4, lines 14-17).

8.   Claims 18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Reichmeyer et al. (hereinafter Reichmeyer)(U.S. Patent No. 6,286,038 B1) and

Choudhry (U.S. Patent No. 6,442,602 B1) in view of Skemer et al. (hereinafter

Skemer)(U.S. Patent No. 6,570,849 B1).

Regarding claims 18 and 31, Reichmeyer and Choudhry teach all the limitations

of claims 17 and 30 as explained above except for using voice over Internet protocol on

the data network.

Skemer teaches as follows:

The Voice over IP gateway for converting telephony and other voice-band signals

and signaling information into IP packets over an access network, which is an

established packet based network (see, e.g., col. 7, line 65 to col. 8, line 4 and figure 1).

It would have been obvious for one of ordinary skill in the art at the time of the

invention to modify Reichmeyer and Choudhry to use data network for voice data on the

basis of the Internet protocol as taught by Skemer in order to utilize existing data

network capacity by interleaving voice IP traffic onto the current data traffic.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jeong S. Park whose telephone number is 571-270-

1597. The examiner can normally be reached on Monday through Thursday 7:30 - 5:00

EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
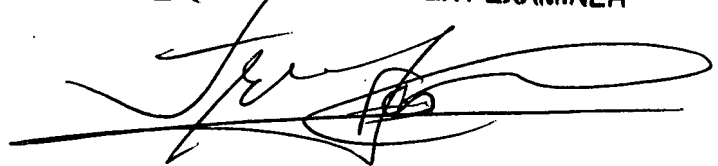
supervisor, Frantz Jules can be reached on 571-272--6681. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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JP
May 11, 2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER